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EXAMINER
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1   UNITED STATES PATENT AND TRADEMARK OFFICE
2   _____
3
4   BEFORE THE BOARD OF PATENT APPEALS
5   AND INTERFERENCES
6   _____
7
8   *Ex parte* ANTHONY R. ROTHSCHILD
9   _____
10
11   Appeal 2011-001313
12   Application 09/755,541
13   Technology Center 3600
14   _____
15
16
17 Before ANTON W. FETTING, MEREDITH C. PETRAVICK, and
18 MICHAEL W. KIM, *Administrative Patent Judges.*
19
20 FETTING, *Administrative Patent Judge.*

21   DECISION ON APPEAL
22

1 STATEMENT OF THE CASE[1]

2   Anthony R. Rothschild (Appellant) seeks review under 35 U.S.C. § 134

3 (2002) of a final rejection of claims 62, 65, 68-70, 73, 75-77, 81, 84, 86-90,

4 and 92-95, the only claims pending in the application on appeal. Oral

5 arguments were presented on March 8, 2011. We have jurisdiction over the

6 appeal pursuant to 35 U.S.C. § 6(b) (2002).

7   The Appellant invented a way of advertising over a wide area network

8 such as the Internet that allows an Internet user to place an advertisement

9 within a personal communication, and provides a recipient of the personal

10 communication requesting additional information with such information

11 regardless of the network device the recipient is using (Specification 1:18-

12 22).

13   An understanding of the invention can be derived from a reading of

14 exemplary claim 62, which is reproduced below [bracketed matter and some

15 paragraphing added].

16   62. A Web host connected to a wide area network (WAN),
17   comprising:

18   [1] a Web server adapted to communicate with a plurality of
19   network devices via said WAN;

20   [2] a memory device connected to said Web server and adapted
21   to store a plurality of advertisements;

22   and

23   [3] an advertising application,

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[1] Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed February 9, 2010) and Reply Brief ("Reply Br.," filed October 20, 2010), and the Examiner's Answer ("Ans.," mailed August 20, 2010).

1   wherein said advertising application provides the
2   functions of:

3   [4] permitting a sender

4   to submit communication data

5   to said Web host

6   and

7   to identify at least one recipient

8   of said communication data;

9   [5] using at least a portion of the content of said
10   communication data

11   to automatically select at least one
12   advertisement

13   from said plurality of advertisements;

14   [6] inserting

15   said at least one advertisement

16   and

17   said communication data

18   into a personal electronic communication,

19   wherein said personal electronic
20   communication comprises an e-mail
21   message;

22   [7] sending said personal electronic
23   communication

24   to said at least one recipient

25   via said WAN;

26   and

27   [8] compensating said sender

28   by providing said sender

29   with a free service

1   in exchange for allowing said Web host to
2   send said personal electronic
3   communication,

4   including said at least one
5   advertisement,

6   to said at least one recipient.

7   The Examiner relies upon the following prior art:

Gabbard   US 6,205,432 B1   Mar. 20, 2001
Roth   US 6,285,987 B1   Sep. 4, 2001

8   Claims 62, 65, 68-70, 73, 75-77, 81, 84, 86-90, and 92-95 stand rejected
9   under 35 U.S.C. § 103(a) as unpatentable over Gabbard and Roth.

ISSUES

11   The issues of obviousness turn primarily on whether it was predictable to
12   select an ad based on textual content and embed such an ad in an email.

FACTS PERTINENT TO THE ISSUES

14   The following enumerated Findings of Fact (FF) are believed to be
15   supported by a preponderance of the evidence.

16   *Facts Related to the Prior Art*

17   *Gabbard*

18   01. Gabbard is directed to an advertisement system and method for
19   inserting into an end user communication message a background
20   reference to an advertisement causing an advertisement image to
21   be tiled, or watermarked, across an end user screen behind the text
22   of an e-mail message or public posting. The message server

4

1   receives an SMTP or NNTP message and transmits an SMTP,

2   POP3 or NNTP message with an HTML portion for a respective

3   HTML-compatible client. Alternately, the message server

4   transmits the entire message in HTML to be used as a stand-alone

5   web page or as a portion of a larger page employing frames or

6   tables. Gabbard 4:6-67.

7   02. Gabbard describes offering a free web-email service in return for

8   using this service. Gabbard 10:8.

9   *Roth*

10   03. Roth is directed to providing advertisements from a central server

11   to viewers who access web sites. A data base includes

12   information about viewers, information about the characteristics

13   of particular web sites and other information relevant to which

14   advertisements should be displayed for particular viewers. Roth

15   evaluates, in real time, bids submitted by different advertisers in

16   order to determine which particular advertisement will be

17   displayed to a viewer. Roth 1:66 − 2:10.

18   04. The fact that a viewer has accessed a web page which has an

19   HTML reference to the advertising server is referred to as a view

20   opportunity or view-op. The characteristics of each view-op

21   include the *characteristics of the particular web site and web page*

22   *being accessed* and the characteristics of the viewer including

23   demographic information about the viewer and information as to

24   what other sites this viewer has accessed in various periods of

25   time. Roth 2:11-19.

1   05. Each advertiser provides one or more "proposed bids" which

2   specify how much the advertiser is willing to pay for displaying a

3   particular advertisement in response to a view-op with certain

4   characteristics. Each proposed bid can specify a price or amount

5   that the advertiser is willing to pay for the opportunity to display

6   an advertisement (a) to a viewer who has a particular set of

7   characteristics and (b) on a web site and web page that meets a

8   particular set of criteria. Each proposed bid can be dependent

9   upon or require satisfaction of various criteria which must be met

10   in order for a bid of a particular amount to be submitted. Roth

11   2:20-47.

12   06. When a view-op arises, the bidding agents evaluate the

13   characteristics of the view-op compared to the specifications in

14   proposed bids and the bidding agents submit bids to the bid

15   selection logic where appropriate. Next, the bid selection logic

16   selects the highest bid from the various available bids and the

17   advertisement which is specified in the highest bid is displayed.

18   Roth 2:54-65.

19   07. Roth describes *using words that must be on the page viewed as*

20   *criteria for ad bidding.* Roth 14:23-24.

21   ANALYSIS

22   The Examiner applied Gabbard to show it was known to insert an ad in

23 an e-mail (FF 01) and applied Roth to show it was known to rely on content

24 to select an ad (FF 03-07). We find the Examiner has completely and

25 properly responded to the arguments in the Appeal Brief. Consequently, we

1　adopt the Examiner's findings of fact and analysis from Answer 3-14 and

2　reach similar legal conclusions. The issues thus reduce down to those

3　presented in the Reply Brief.

4　　　We are not persuaded by the Appellant's argument that

5　　　　Roth does not use content data to select an advertisement from
6　　　　a plurality of advertisements, wherein the selected
7　　　　advertisement is inserted into a web page

8　Reply Br. 3-7. Appellant contends that Roth relies on bids to select ads.

9　These bids, however, are formed based on criteria including page content.

10　FF 04-07. The limitation at issue is "using at least a portion of the content of

11　said communication data to automatically select at least one advertisement."

12　There is no further narrowing of the manner or level of use. Clearly using a

13　portion of the content to form a bid which in turn is used to select an

14　advertisement is within the scope of the claimed use.

15　　　We are not persuaded by the Appellant's argument that

16　　　　[i]t would not have been obvious to combine the Internet
17　　　　advertising system of Roth with the email advertising system of
18　　　　Gabbard

19　Reply Br. 7-14. Again, the Examiner applied Gabbard to show it was

20　known to insert an ad into an e-mail and Roth to show it was known to select

21　the ad based on the textual content of a message. Roth is directed to

22　selecting an ad for internet usage, and Gabbard is directed to imbedding such

23　an ad in an email. Thus, Roth is directed to ad selection and Gabbard to ad

24　delivery. One of ordinary skill in the marketing arts knew that both

25　selecting the appropriate ad and delivery vehicle were critical in ad

26　effectiveness. Thus, it was predictable to select references that described

1   each of ad selection and delivery, and apply both to ensure such

2   effectiveness.

3   The Appellant also contends as part of this argument, that one of

4   ordinary skill would not have known how to extract the words in Gabbard's

5   email for use in Roth's selection criteria. The Examiner found that simple

6   parsing would do so. Appellant contends there is no evidence that one of

7   ordinary skill knew how to perform such parsing.

8   The Examiner was simply taking notice of the fact that parsing is one of

9   the first techniques undergraduate computer science majors learn, and is

10   typically a freshman or sophomore level exercise. One of ordinary skill out

11   of school and practicing the internet programming arts would have been all

12   too familiar with parsing text to extract words. This is in fact evidenced by

13   Roth's very use of web pages and Gabbard's very use of email. Web pages

14   are written in HTML, which requires parsing to display on a screen. Email

15   contains fields directing the message to a particular computer and user, also

16   requiring parsing to extract the data in the fields.

17   We are not persuaded by the Appellant's claim 88 argument that

18   THE PRIOR ART DOES NOT DISCLOSE USING
19   CONTENT OF AN EMAIL AND ADVERTISEMENT-TYPE
20   DATA TO SELECT AN ADVERTISEMENT FROM A
21   PLURALITY OF ADVERTISEMENTS AND INSERTING
22   THE SELECTED ADVERTISEMENT INTO THE EMAIL

23   Reply Br. 15-17. This argument is similar to that made in support of

24   claim 62. Claim 88 depends from claim 87, also similar to claim 62, and

25   recites further

26   allowing a sender to select a type of advertisement that can be
27   included in said personal communication by submitting

1   advertisement-type data, said sender-provided data further
2   comprising said advertisement-type data; and using said at least
3   a portion of said communication data and said advertisement-
4   type data to select said at least one of said plurality of
5   advertisements.

6   Appellant contends that Roth's user is not the sender. That is not the

7   issue. Gabbard clearly has two senders, the party sending the email and the

8   party embedding the ad which is also sent. The party who selects the ad to

9   be sent is a sender at least in the sense the ad selected by that party is sent.

10   CONCLUSIONS OF LAW

11   The rejection of claims 62, 65, 68-70, 73, 75-77, 81, 84, 86-90, and 92-

12   95 under 35 U.S.C. § 103(a) as unpatentable over Gabbard and Roth is

13   proper.

14   DECISION

15   The rejection of claims 62, 65, 68-70, 73, 75-77, 81, 84, 86-90, and 92-

16   95 is affirmed.

17   No time period for taking any subsequent action in connection with this

18   appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.

19   § 1.136(a)(1)(iv) (2007).

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21   AFFIRMED

22

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25   MP